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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,508	04/12/2004	Leslie Yeh	Google-56CIP1 (GP-145-01-	3269
26479	7590	05/24/2007	EXAMINER	
STRAUB & POKOTYLO 620 TINTON AVENUE BLDG. B, 2ND FLOOR TINTON FALLS, NJ 07724			ROBINSON, GRETA LEE	
			ART UNIT	PAPER NUMBER
			2168	
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			05/24/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/823,508	<b>Applicant(s)</b> YEH ET AL.	
	<b>Examiner</b> Greta L. Robinson	<b>Art Unit</b> 2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-28 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I claims 1-6 and 15-20 in the reply filed on March 12, 2007 is acknowledged. The traversal is on the ground(s) that the claimed inventions are capable of use together and do not require different modes of operation. Non-elected claims 7 and 21 have been amended to depend from claims elected claims 1 and 15 to further clarify invention. Applicant's *remarks* and *amendment* are found persuasive. The restriction the restriction requirement as set forth in the Office action mailed on October 05, 2006 is hereby withdrawn. Previously withdrawn from consideration as a result of a restriction requirement, claims 7-14 and 21-28 are hereby rejoined and fully examined for patentability under 37 CFR 1.104. MPEP § 821.

2. Claims 1-28 are pending in the present application. Claims 7 and 21 have been amended. Claims 7-14 and 21-28 previously withdrawn have been rejoined in view of Applicant's amendment and remarks.

### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 1070 see Figure 10. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the

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description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to because the logical connection between reference characters within the flowchart of Figure 10 is not clear. Note reference character 1020 "INPUT TYPE" flows to "EXIT"; however this points to "RETURN" reference character 1070 see Figure 10, and page 25 lines 7-29. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet

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submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

## **5. INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

### **Replacement Drawing Sheets**

Drawing changes must be made by presenting replacement sheets which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments section, or remarks, section of the amendment paper. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). A replacement sheet must include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and within the top margin.

### **Annotated Drawing Sheets**

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheet(s) must be clearly labeled as "Annotated Sheet" and must be presented in the amendment or remarks section that explains the change(s) to the drawings.

### **Timing of Corrections**

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Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-3 and 15-17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 13-15 of copending Application No. 10/654265. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is well settled that the omission of elements and their functioning is an obvious expedient if the remaining

elements and their functioning if the remaining elements perform the same function as before. See *In re Karlson*, 136 USPQ 184 (CCPA 1963).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Regarding claims 1-3, a method for determining a relevancy of an ad to a request [note: claims 1-3 of application serial no. 10/654265]. The claims are similar in scope except for the descriptive element of the geographical information being inter-country geolocation information.

Regarding claims 15-17 an apparatus for determining a relevancy of an ad to a request [see: claims 13-15 of application serial no. 10/654265]. The claims are similar in scope except for the descriptive element of the geographical information being inter-country geolocation information. The limitation "means for accepting geolocation information" is interpreted as equivalent to "accepting geological information", i.e. both limitations perform the same function.

### ***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claims are directed to an abstract idea and do not include a useful concrete tangible result. The preamble of each

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claim sets out to determine the relevancy or score of an ad to a request; however the body of the claim omits an operational procedure to display results to an end user. Also, the claims omit concrete limitation as to whether a comparison is actually generated [see: claim 1 lines 7-8; claim 11 lines 7-8; claim 13 lines 7-8; claim 15 lines 7-8; claim 25 lines 7-8; and claim 27 lines 7-8]; and an operational procedure for the alternative limitation "if" it is not determined that an ad does not have a geolocation price information [see: claim 7 lines 9-12; and claim 21 lines 10-12]. Claims 2-10, 12, 14, 16-24, 26 and 28 are rejected based on dependency.

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: a display of results to an end user [note: independent claims 1, 11, 13, 15, 25 and 27]; and an operational procedure for "if" it is not determined that an ad has a geolocation price information [note: claims 7 and 21]. Claims 2-10, 12, 14, 16-24, 26 and 28 are rejected based on dependency.



***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1-4, 11-18 and 25-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Herz et al. US Patent 5,754,939.

Regarding claim 1, **Herz et al.** teaches a method for determining a relevancy of an ad to a request [note: abstract customized electronic identification of desirable objects ], the method comprising:

accepting geolocation information associated with the request [note: col. 8 lines 46-67 the computed similarity measure serve as input at one or more locations in a data communications network; col. 9 lines 1-55 classical Information Retrieval System (IR) technology];

comparing the accepted geolocation information associated with the request with geolocation targeting information associated with the ad to generate a comparison [note: Figure 10 (1103) compare; also note col. 8 lines 46-67 through col. 9 lines 1-55];

determining the relevancy of the ad using at least the comparison, wherein the geolocation targeting information associated with the ad is defined by at least one

geographic reference point [note: col. 10 lines 61-67 to col. 11 lines 1-67; Figure 10 (1108) ].

Regarding claim 2, Hertz et al. teaches wherein the request further includes search terms, and wherein the act of determining the relevancy of the of further uses a comparison of keywords ... [note: col. 57 lines 49-67 to col. 58 lines 1-24; col. 60 lines 7-67 to col. 61 lines 1-54].

Regarding claim 3, Hertz et al. teaches wherein the request further includes document relevance information ... [note: col. 57 lines 49-67 to col. 58 lines 1-24].

Regarding claim 4, Hertz et al. teaches wherein the geolocation targeting information corresponds to a circular area having a radius about a specified geographic [note: col. 10 lines 61-67; col. 11 lines 1-67].

14. The limitations of claims 15-18 parallel claims 1-4; therefor they are rejected under the same rationale.

15. Regarding claim 11, Herz et al. teaches a method for determining a score of an ad to a request [note: abstract customized electronic identification of desirable objects ], the method comprising:

accepting geolocation information associated with the request [note: col. 8 lines 46-67 the computed similarity measure serve as input at one or more locations in a data communications network; col. 9 lines 1-55 classical Information Retrieval System (IR) technology];

comparing the accepted geolocation information associated with the request with geolocation targeting information associated with the ad to generate a comparison [note: Figure 10 (1103) compare; also note col. 8 lines 46-67 through col. 9 lines 1-55];

determining the score of the ad using at least the comparison, wherein the geolocation information is a zip code included in the request [note: col. 10 lines 61-67 to col. 11 lines 1-67 domain example ... zip code ; Figure 10 (1108); weights may be set by the administrator see col. 21 lines 44-57; also see col. 17 line 50 through col. 18 line 18 ].

Regarding claim 12, wherein the request is a search query [note: col. 9 lines 4-7 IR technology].

Regarding claim 13, wherein the geolocation information is at least one of a city name, a street name ... [note: col. 11 lines 17-67 domain example].

16. The limitations of claims 14, and 25-28 parallel claims 11-13 therefore the are rejected under the same rationale.

### ***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ponte US Patent 7,047,242 B1

Getchius et al. US Patent 6,643,640 B1

Cui et al. US Patent Application Publication No. 2005/0021397 A1

Kamanger et al. US Patent Application Publication No. 2003/0046161 A1

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greta L. Robinson whose telephone number is (571)272-4118. The examiner can normally be reached on M-F 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim T. Vo can be reached on (571)272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



GRETAL ROBINSON  
PRIMARY EXAMINER

Greta Robinson  
Primary Examiner  
May 22, 2007